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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,292	09/22/2003	Wei-Han Chang	TOP 331	5626

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04/06/2007

EXAMINER

MIRZADEGAN, SAEED S

ART UNIT	PAPER NUMBER
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2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

31

Office Action Summary

Application No.

10/665,292

Applicant(s)

CHANG ET AL.

Examiner

Saeed S. Mirzadegan

Art Unit

2109

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION***Drawings***

1. The drawings are objected to because Fig. 2, item 20 refers to a LAN connected to the motherboard 23. The motherboard is to be connected to the LAN (local area network) via a Network Interface Card (NIC) and not directly. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

1. The disclosure is objected to because of the following informalities: "peripheral terminal" should be changed to "peripheral device", "pre-storing" should be changed to "restoring", "hidden" should be changed to "disabled", in numerous locations.

Appropriate correction is required.

Claim Objections

2. **Claim 1** is objected to because of the following informalities: "peripheral terminal" should be changed to "peripheral device".

Appropriate correction is required.

3. **Claim 1** is objected to because of the following informalities: "pre-storing" should be changed to "restoring".

Appropriate correction is required.

4. **Claim 2** is objected to because of the following informalities: "backing up" should be changed to "restoring".

Appropriate correction is required.

5. **Claim 3** is objected to because of the following informalities: "backing up" should be changed to "restoring".

Appropriate correction is required.

Art Unit: 2109

6. **Claim 4** is objected to because of the following informalities: "peripheral terminal is a local area network (LAN)" should be changed to "peripheral device is in a local area network (LAN)".

Appropriate correction is required.

7. **Claim 5** is objected to because of the following informalities: "peripheral terminal" should be changed to "peripheral device".

Appropriate correction is required.

8. **Claim 6** is objected to because of the following informalities: "determined" should be changed to "pre determined".

Appropriate correction is required.

9. **Claim 6** is objected to because of the following informalities: "hiding a" should be changed to "disabling the".

Appropriate correction is required.

10. **Claim 7** is objected to because of the following informalities: "determined" should be changed to "pre determined".

Appropriate correction is required.

Art Unit: 2109

11. **Claim 7** is objected to because of the following informalities: "hiding" should be changed to "disabling".

Appropriate correction is required.

12. **Claim 9** is objected to because of the following informalities: "A method of" should be changed to "The method of".

Appropriate correction is required.

13. **Claim 10** is objected to because of the following informalities: "peripheral terminal" should be changed to "peripheral device".

Appropriate correction is required.

14. **Claim 11** is objected to because of the following informalities: "backing up" should be changed to "restoring".

Appropriate correction is required.

15. **Claim 12** is objected to because of the following informalities: "backing up" should be changed to "restoring".

Appropriate correction is required.

16. **Claim 13** is objected to because of the following informalities: "peripheral terminal" should be changed to "peripheral device".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. **Claims 1-7, 9-13** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

18. **Claim 1, 4, 5, 10, & 13** recites the limitation "peripheral terminal" page 6, lines 2, 20 & 22. There is insufficient antecedent basis for this limitation in the claim. For purposes of applying prior art, the examiner interprets this as intending to read "peripheral device".

19. **Claim 1** recites the limitation "capable of pre-storing" in line 10, page 6. There is insufficient antecedent basis for this limitation in the claim. For purposes of applying prior art, the examiner interprets this as intending to read "capable of restoring".

Art Unit: 2109

20. **Claims 2, 3, 11 & 12** recite the limitation "backing up" in lines 13 & 17, page 6, lines 16 & 20, page 8. There is insufficient antecedent basis for this limitation in the claim. For purposes of applying prior art, the examiner interprets this as intending to read "restoring".

21. **Claims 6 & 7** recite the limitation "determined" in lines 5 & 13, page 7. There is insufficient antecedent basis for this limitation in the claim. For purposes of applying prior art, the examiner interprets this as intending to read "pre determined".

22. **Claim 9** recites the limitation "A method of" in line 1, page 8. There is insufficient antecedent basis for this limitation in the claim. For purposes of applying prior art, the examiner interprets this as intending to read "The method of".

23. **Claims 1-7, 9-13** are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2109

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

24. **Claims 1-4, 6, 9, 10-12, 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (US Patent No. 6438687B2 hereafter "Klein") in view of DMI V2.0 Update.

25. Regarding **Claim 1,10** Klein discloses a method of write-protecting a MAC address of a peripheral terminal, wherein the MAC address is stored in a first memory (CMOS memory) (**col. 2, lines 38-39 (where the MAC address is defined as a BIOS or CMOS memory setting)**), and a backup MAC address is stored in a second memory (DMI Flash Memory) (**col. 2, lines 41-44**), the method comprising: disabling programs capable of erasing the MAC address stored in the first memory; executing a DMI setting to write-protect the MAC address stored in the second memory; and providing a program capable of pre-storing the original MAC address (**col. 4, lines 43-54**).

26. Regarding **Claim 1,10** Klein does not teach DMI memory.

Art Unit: 2109

27. DMI memory, a term not commonly used in the art, is defined as being memory that stores information according to DMI standard. .

28. In the same field of endeavor, DMI V2.0 Update teaches, **(page 2, lines 8-13, DMI memory)**.

29. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the DMI memory as disclosed by DMI V2.0 Update in the method disclosed by Klein. It would have been obvious because the DMI memory would allow DMI-enabled management application to access the configuration information disclosed by Klein.

30. Regarding **Claim 2,11** Klein and DMI update V2.0 disclose the method of claims 1&10 further comprising: backing up the MAC address stored in the first memory using the MAC address stored in the second memory when the MAC address stored in the first memory is incorrect **(col. 2, lines 44-46)**.

31. Regarding **Claim 3,12** Klein and DMI update V2.0 disclose the method of claims 1&10 further comprising: backing up the MAC address stored in the second memory using the MAC address stored in the first memory when the MAC address stored in the second memory is incorrect **(col. 2, lines 46-51)**.

Art Unit: 2109

32. Regarding **Claim 4**, Klein and DMI update V2.0 disclose the method of claim 1, wherein the peripheral terminal is a local area network (LAN) (**col. 1, lines 27-29**).

33. Regarding **Claim 6**, Klein and DMI update V2.0 discloses the method of claim 1, further comprising: checking whether an identification code of a MAC address stored in the second memory is correct (**col. 2, lines 22-28**); checking whether the MAC address stored in the first memory is correct if the MAC address stored in the second memory is correct; copying the MAC address stored in the second memory to a determined register if the MAC address stored in the first memory is incorrect; and hiding a function of setting the MAC address (**col. 2, lines 35-44**).

34. Regarding **Claim 9,14** Klein and DMI update V2.0 disclose the method of claims 1&10, wherein the second memory is a non-volatile memory (**col. 2, lines 41-42 & col. 4, lines 9-11**).

35. **Claims 5,13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein with DMI V2.0 Update as applied to claims 1 and 10 above, in view of Microsoft Computer Dictionary.

36. Regarding **Claim 5,13**, Klein and DMI update V2.0 disclose the method of claims 1 and 10.

Art Unit: 2109

37. Regarding **Claim 5,13** Klein and DMI update V2.0 do not teach the peripheral terminal is an IEEE1394 device.

38. In the same field of endeavor, Microsoft Computer Dictionary teaches IEEE 1394 (page 265, col. 1, lines 22-37).

39. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the IEEE1394 device as disclosed by Microsoft Computer Dictionary in the method disclosed by Klein. It would have been obvious because the inclusion of IEEE 1394 devices would expand the type of I/O devices that are serviced by the method disclosed by Klein.

40. **Claims 7,8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein with DMI V2.0 Update as applied to claim 6 above, in view of Shinjo et al. (US Patent No. 5269022 hereafter "Shinjo et al.").

41. Regarding **Claim 7**, Klein and DMI update V2.0 discloses the method of claim 6, further comprising: when the identification code of the MAC address stored in the second memory is erroneous; determining whether the identification code of the MAC address in the second memory has been updated; copying the MAC address stored in

Art Unit: 2109

the second memory in a determined register; and hiding the setting function of the MAC address. (**FIG. 2A & 2B**).

42. Regarding **Claim 7** Klein and DMI update V2.0 do not teach setting the updated flag of the MAC address of the second memory if the identification code of the MAC address of the second memory has been updated.

43. In the same field of endeavor, Shinjo et al. teach setting the updated flag of the MAC address of the second memory if the identification code of the MAC address of the second memory has been updated (**Fig. 2 & col. 1, lines 38-48 & lines 53-64**).

44. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine setting the update flags as disclosed by Shinjo et al. in the method disclosed by Klein and DMI V2.0 update. It would have been obvious because the setting of the update flags would eliminate the possibility of unnecessary replacement of the content of the memory a second time.

45. Regarding **Claim 8**, Klein and DMI update V2.0 discloses the method of claim 6, further comprising: if the identification code (checksum) of the MAC address in the second memory has not been updated; determining whether the identification code stored in the first memory is correct; copying the MAC address in the first memory to

Art Unit: 2109

the second memory if the identification code in the first memory is correct; and setting the updated flag of the MAC address in the second memory (**FIG. 2A & 2B**).

46. Regarding **Claim 8** Klein and DMI update V2.0 do not teach setting the updated flag of the MAC address of the second memory.

47. In the same field of endeavor, Shinjo et al. teach setting the updated flag of the MAC address of the first memory if the identification code of the MAC address of the first memory has been updated (**Fig. 2 & col. 1, lines 38-48 & lines 53-64**).

48. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine setting the update flags as disclosed by Shinjo et al. in the method disclosed by Klein and DMI V2.0 update. It would have been obvious because the setting of the update flags would eliminate the possibility of unnecessary replacement of the content of the memory a second time.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ewertz et al. (US Patent No. 5371876) teach Computer system with a paged non-volatile memory, Johnson et al. (US Patent No. 5542077) teach Personal computer with CMOS memory not having a separate battery, Klein (US Patent No. 6282640) teaches Method for improved storage of computer system configuration information, Klein (US Patent No. 5938764) teaches Apparatus for improved storage of computer system configuration information, Wadsworth et al. (US Patent No. 5657448) teach System for an interactive network board remotely configurable by selecting from a plurality of functionality defining software such as printer server stored in PROM.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeed S. Mirzadegan whose telephone number is 571-270-3044. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Assouad can be reached on 571-272-2210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2109

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SSM



**PATRICK ASSOUD
SUPERVISORY PATENT EXAMINER**